

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Edward DRATZ et al.

Confirmation No.: 4463

Patent No.: 7,582,260

Group Art Unit: 1797

Issue Date: September 1, 2009

Examiner: Lore Ramillano Jarrett

Appln. No.: 10/761,818

Filed: January 20, 2004

For: NOVEL ZWITTERIONIC DYES FOR LABELING IN PROTEOMIC AND OTHER  
BIOLOGICAL ANALYSES

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Commissioner for Patents  
**Mail Stop Petitions**  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§1.704 & 1.705**

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on September 1, 2009 as U.S. Patent No. 7,582,260. This request is timely filed within 2 months from the date of issue because November 1, 2009 was a Sunday, and this request is therefore, a timely response under 37 CFR §1.705(d).

The USPTO determined that the patent was entitled to 737 days of PTA. See attached USPTO PTA calculation. Applicants believe that this PTA determination was made in accordance with the USPTO's interpretation of the "Explanation of 37 CFR §1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (June 21, 2004). Under that interpretation of the PTA statute, any USPTO delay under 35 U.S.C. §154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. §154(b)(1)(B), and so as a practical effect, PTA may be awarded under 35 U.S.C. §154(b)(1)(A) or 35 U.S.C. §154(b)(1)(B), but never both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision holding that the USPTO's interpretation of the PTA statute was incorrect. See *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that the PTA statute should properly be interpreted so that "the only way that periods of time can overlap is if they occur on the same day." *Wyeth*, slip op. at 8. Thus, *Wyeth* holds that a USPTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." *Id.* Applicants are aware that this district court decision has been appealed to the U.S. Court of Appeals for the Federal Circuit (CAFC) (Fed. Cir. No. 2009-1120) but that no decision has yet been issued. Applicants, therefore, request that a decision on this request be held in abeyance until the CAFC decides this appeal, particularly because the oral argument for this appeal was heard on October 7, 2009.

Applicants have recalculated the PTA for the above-identified patent under the court's interpretation of the PTA statute in *Wyeth*, and have determined that the patent is entitled to 1313 days PTA, when taking into account the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b). There was a 576 day delay by the USPTO under 35 U.S.C. §154(b)(1)(A) ("A Delay") and a 955 day delay by the USPTO under 35 U.S.C. §154(b)(1)(B) ("B Delay"), which should be added together totaling 1531 combined days minus any physically overlapping PTO delays (0 days) under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) which equals 1531 days minus any Applicants' delay (218 days).

(a) Total of PTO delay under §154(b)(1)(A) & (B):	1531 days
(b) Total of overlapping PTO delay under §154(b)(1)(A) & (B):	0 days
(c) Total Applicant delay:	218 days
Final PTA Determination:	1313 days

Applicants therefore respectfully request that the patent be accorded 1313 days PTA or should this calculation be erroneous and Applicants would be entitled to additional PTA, it is kindly requested that the USPTO award a longer PTA if Applicants are so entitled under the *Wyeth* ruling.


The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1283.

Respectfully submitted,  
**COOLEY GODWARD KRONISH LLP**

Dated: November 2, 2009

By:

  
Jayme A. Huleatt  
Reg. No. 34,485

COOLEY GODWARD KRONISH LLP  
ATTN: Patent Group  
777 6<sup>th</sup> Street, NW, Suite 1100  
Washington, DC 20001  
Tel: (415) 693-2302  
Fax: (415) 693-2222

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### Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/761,818

Filing or 371(c) Date:	01-20-2004	USPTO Delay (PTO) Delay (days):	955
Issue Date of Patent:	09-01-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	218
Post-Issue Petitions (days):	+0	Total PTA (days):	737
USPTO Adjustment(days):	+0	Explanation Of Calculations	

### Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
08-12-2009	PTA 36 Months	379	
09-01-2009	Patent Issue Date Used in PTA Calculation		
07-06-2009	Dispatch to FDC	⬆	
07-06-2009	Application Is Considered Ready for Issue	⬆	
07-01-2009	Issue Fee Payment Verified	⬆	
07-01-2009	Issue Fee Payment Received	⬆	
04-03-2009	Mail Notice of Allowance	⬆	
03-30-2009	Document Verification	⬆	
03-30-2009	Notice of Allowance Data Verification Completed	⬆	
03-30-2009	Case Docketed to Examiner in GAU	⬆	
03-19-2009	Examiner Interview Summary Record (PTOL - 413)	⬆	
03-30-2009	Examiner's Amendment Communication	⬆	
03-09-2009	Date Forwarded to Examiner	⬆	
02-03-2009	Amendment/Argument after Notice of Appeal	⬆	
12-22-2008	Mail Advisory Action (PTOL - 303)	⬆	
12-18-2008	Advisory Action (PTOL-303)	⬆	
12-16-2008	Date Forwarded to Examiner	⬆	
12-12-2008	Amendment/Argument after Notice of Appeal	⬆	
12-12-2008	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	⬆	
12-12-2008	Notice of Appeal Filed		91
12-12-2008	Request for Extension of Time - Granted		⬆
06-12-2008	Mail Final Rejection (PTOL - 326)		⬆
06-09-2008	Final Rejection		
04-03-2008	Date Forwarded to Examiner		
04-02-2008	Response after Non-Final Action		91
04-02-2008	Request for Extension of Time - Granted		⬆
10-05-2007	Case Docketed to Examiner in GAU		⬆
10-02-2007	Mail Non-Final Rejection		⬆
09-28-2007	Non-Final Rejection		
04-14-2006	Information Disclosure Statement considered		
09-28-2007	Case Docketed to Examiner in GAU		

07-19-2007	Date Forwarded to Examiner	
07-11-2007	Response to Election / Restriction Filed	
07-11-2007	Request for Extension of Time - Granted	
05-15-2007	Case Docketed to Examiner in GAU	
05-11-2007	Mail Restriction Requirement	
05-09-2007	Requirement for Restriction / Election	
03-03-2007	Date Forwarded to Examiner	
02-22-2007	Response to Election / Restriction Filed	36
02-22-2007	Request for Extension of Time - Granted	⬆
02-26-2007	Correspondence Address Change	⬆
02-26-2007	Change in Power of Attorney (May Include Associate POA)	⬆
10-17-2006	Mail Restriction Requirement	576
10-02-2006	Requirement for Restriction / Election	⬆
09-14-2006	Case Docketed to Examiner in GAU	⬆
04-14-2006	Reference capture on IDS	⬆
04-24-2006	Miscellaneous Incoming Letter	⬆
04-20-2006	Correspondence Address Change	⬆
04-20-2006	IFW TSS Processing by Tech Center Complete	⬆
04-14-2006	Information Disclosure Statement (IDS) Filed	⬆
04-14-2006	Information Disclosure Statement (IDS) Filed	⬆
08-26-2004	Receipt of all Acknowledgement Letters	⬆
08-26-2004	Receipt of Acknowledgment Letter	⬆
08-03-2004	Application Return from OIPE	⬆
08-03-2004	Application Is Now Complete	⬆
08-03-2004	Application Return TO OIPE	⬆
08-03-2004	Application Return from OIPE	⬆
08-03-2004	Application Return TO OIPE	⬆
08-03-2004	Application Dispatched from OIPE	⬆
08-03-2004	Application Is Now Complete	⬆
07-12-2004	Additional Application Filing Fees	⬆
07-12-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	⬆
05-11-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	⬆
03-17-2004	Referred by L&R for Third-Level Security Review. Agency Referral Letter Generated	⬆
03-08-2004	Referred to Level 2 (LARS) by OIPE CSR	⬆
02-02-2004	IFW Scan & PACR Auto Security Review	⬆
01-20-2004	Initial Exam Team nn	⬆

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